

**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS**

CONFORMIS, INC.,

Plaintiff,

v.

ACACIA RESEARCH
GROUP LLC, ADVANCED SKELETAL
INNOVATIONS LLC, BONUTTI
SKELETAL INNOVATIONS LLC, and
PHILLIP MITCHELL,

Defendants.

CIVIL ACTION NO. 1:13-cv-10377-PBS

**JOINT MOTION TO STAY
CONFORMIS, INC. V. ACACIA RESEARCH GROUP LLC, ET AL.**

WHEREAS, Bonutti Skeletal Innovations LLC (“Bonutti”) commenced an action against ConforMIS, Inc. (“ConforMIS”) on September 10, 2012, *Bonutti Skeletal Innovations v. ConforMIS, Inc.*, Civil Action No. 1:12-cv-01109-GMS (“the Delaware action”), which relates to alleged infringement of U.S. Patent No. 7,806,896 (the “’896 patent”);

WHEREAS, Plaintiff ConforMIS brought the above-captioned action (“the Massachusetts action”) against Defendants Acacia Research Group LLC (“Acacia”), Advanced Skeletal Innovations LLC (“Advanced Skeletal”), Bonutti Skeletal Innovations LLC, and Phillip Mitchell on February 25, 2013, for declaratory judgment of noninfringement and invalidity of the ’896 patent, as well as for Massachusetts state law claims of breach of contract, misappropriation, misrepresentation, and unfair business practices (D.I. 1);

WHEREAS, ConforMIS filed a Motion to Dismiss for Failure to State a Claim, or, Alternatively, to Transfer to the United States District Court for the District of Massachusetts,

(*Bonutti Skeletal Innovations v. ConforMIS, Inc.*, Civil Action No. 1:12-cv-01109-GMS, Dkt. 10), on February 25, 2013 in the Delaware action, which is currently pending before that court;

WHEREAS, Acacia and Phillip Mitchell filed a Joint Motion to Dismiss, (D.I. 29), on April 22, 2013 in the Massachusetts action;

WHEREAS, Advanced Skeletal filed a Motion to Dismiss, (D.I. 32), on April 22, 2013 in the Massachusetts action;

WHEREAS, Bonutti filed a Motion to Sever and Dismiss, or in the Alternative Transfer the Claims Against Bonutti Skeletal Innovations LLC to the District of Delaware, (D.I. 33), on April 22, 2013 in the Massachusetts action;

WHEREAS, the parties to the Massachusetts action have agreed to a procedure to streamline the resolution of disputed issues, and to conserve the parties' and judicial resources, by staying this action pending the resolution of ConforMIS's Motion to Dismiss for Failure to State a Claim, or, Alternatively, to Transfer to the United States District Court for the District of Massachusetts that is currently pending before the United States District Court of the District of Delaware ("Delaware Court");

THE PARTIES HEREBY MOVE THE COURT TO ORDER:

1. The Massachusetts action is stayed in its entirety pending resolution of ConforMIS's Motion to Dismiss for Failure to State a Claim, or, Alternatively, to Transfer to the United States District Court for the District of Massachusetts, currently pending before the Delaware Court.

2. Should the Delaware Court grant ConforMIS's motion to transfer the Delaware action to the United States District Court for the District of Massachusetts, or dismiss Bonutti's complaint without leave to amend, the parties shall resume litigation before this Court and

litigate any issues arising from ConforMIS's alleged infringement of the '896 patent in this action. In such an event, the parties shall address any issues remaining in Acacia and Philip Mitchell's Joint Motion to Dismiss, Advanced Skeletal's Motion to Dismiss, and Bonutti's Motion to Sever and Dismiss, or in the Alternative Transfer the Claims Against Bonutti Skeletal Innovations LLC to the District of Delaware.

3. Should the Delaware Court deny ConforMIS's motion to transfer the Delaware action to the United States District Court for the District of Massachusetts on the merits, the parties agree to proceed with the litigation in the United States District Court for the District of Delaware. In such an event, ConforMIS shall dismiss all of its claims against Acacia, Advanced Skeletal, Bonutti, and Phillip Mitchell in the Massachusetts action without prejudice, and raise those claims, as necessary, in the United States District Court of the District of Delaware. In such an event, Acacia, Phillip Mitchell, and Advanced Skeletal agree not to contest personal or subject matter jurisdiction over ConforMIS's Massachusetts state law claims, but shall have an opportunity to move to dismiss ConforMIS's claims on the bases raised by those parties in the Massachusetts action.

4. Should the Delaware Court dismiss Bonutti's complaint with leave to amend, but not rule on ConforMIS's motion to transfer on the merits, the parties agree that the Massachusetts action shall remain stayed, that Bonutti shall have an opportunity to amend its complaint in the Delaware action, and that the parties shall proceed before the Delaware Court until such time as Bonutti's complaint is dismissed without leave to amend, or the Delaware Court decides ConforMIS's motion to transfer on the merits.

5. While the Massachusetts action is stayed, the parties shall jointly update this Court from time-to-time, as necessary, to apprise it of developments in the Delaware action.

6. In any event, the parties shall jointly inform this Court within seven (7) calendar days of the Delaware Court reaching a final decision on the merits regarding ConforMIS's Motion to Dismiss for Failure to State a Claim, or, Alternatively, to Transfer to the United States District Court for the District of Massachusetts, at which time either ConforMIS will move to dismiss its complaint without prejudice or the parties will jointly move to lift the stay.

7. Notwithstanding the foregoing, the parties may move to lift this stay for good cause shown or any circumstance which, in the Court's judgment, renders enforcement of this stipulation unjust or inequitable.

8. Should the stay be lifted in this action, the parties shall jointly request, within twenty-one (21) calendar days of lifting the stay, a scheduling conference and shall provide the Court with the parties' positions regarding a proposed schedule for completing the briefing on the Defendants' motions to dismiss.

Dated: May 15, 2013

Respectfully submitted,

/s/ Sanya Sukduang

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Based on the foregoing, IT IS SO ORDERED.

Dated: _____

Hon. Patti B. Saris
United States District Judge

CERTIFICATE OF SERVICE

I hereby certify that this document filed through the CM/ECF system will be sent electronically to the registered participants as identified on the NEF (NEF) and paper copies will be sent to those indicated as non registered participants on May 15, 2013.

/s/Sanya Sukduang
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